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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,191	12/22/2000	Eiroku Go	505500-56	1331

7590 04/21/2004  
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EXAMINER

DAVIS, TEMICA M

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/746,191

**Applicant(s)**

GO, EIROKU

**Examiner**

Temica M. Davis

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed January 29, 2004 have been fully considered but they are not persuasive.

Applicant argues that claim 1 is not obvious over Calvert and Hymel, specifically because Hymel fails to disclose classifying emergency information. The examiner disagrees. Calvert discloses a system, which broadcasts and displays requested information to a user of a mobile device (col. 6, line 66-col. 7, line 11). This information consists of advertisements or enhancement products (col. 10, lines 41-45). Calvert further discloses wherein the advertisements/products discussed throughout refer to any type of goods or services (col. 3, lines 14-17).

Further, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to motivate or combine Calvert with Hymel came from Calvert, in that the information broadcast to the user can be any type of service as explained above. Hymel was only brought in to show that it is known in the art to broadcast news and/or weather information to be displayed to a user of a mobile device (col. 1, lines 23-27).

Regarding news and weather not being emergency information, the examiner disagrees because "an emergency situation" is relative to the person receiving the news or weather. It is known in the art that the news and the weather both give valuable information to users, and based on who is receiving the information, this information may be deemed an emergency situation to one and deemed a non-emergency situation to another.

Therefore, Calvert, taken in reasonable combination with Hymel, meets the claimed limitations and the rejection stands as set forth below.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calvert, U.S. Patent No. 6,526,275 in view of Hymel et al (Hymel), U.S. Patent No. 6,031,467.

Regarding claim 1, Calvert discloses a digital advertising method in a cellular telephone system comprising broadcasting selected advertisements for display on a display screen of a cellular telephone receiver receiving a request call in the system; and displaying the selected advertisements on the cellular telephone display screen of the receiver (col. 6, line 66-col. 7, line 30 and col. 10, lines 33-49) and classifying said

advertisements into respective categories among which pre-selected and approved categories advertisements by the receiver are received on said display screen (col. 12, lines 37-52 and col. 16, lines 40-56).

Calvert fails to disclose wherein the classifying step includes classifying emergency information.

Calvert, however, discloses that the products discussed throughout refer to any type of goods or services that may be provided to a user of a communication device (col. 3, lines 14-17).

In a similar field of endeavor, Hymel discloses a method of advertising messages to a selective call receiver. Hymel further discloses wherein these messages include weather and news (col. 1, lines 23-27).

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Calvert with Hymel since it is known in the art that news and weather alerts are used to inform users of emergency situations in order to increase user safety in emergency situations.

Regarding claim 4, the combination of Calvert and Hymel discloses the digital advertising method according to claim 1 further including digital broadcast type advertising and the broadcasting step includes advertising data, advertiser's inquiry telephone number, data and web site address in the advertisements for transfer to the receiver (Calvert, col. 8, lines 41-47).

Regarding claim 5, the combination of Calvert and Hymel discloses the digital advertising method according to claim 4 including storing the transferred contents of

advertisements in a memory installed in said receiver cellular telephone (Calvert, col. 7, lines 12-21).

Regarding claim 6, the combination of Calvert and Hymel discloses the digital advertising method according to claim 5 further including the step of replaying said stored contents of said advertisements on the screen of the cellular telephone by pushing predetermined function keys (Calvert, col. 7, lines 12-21).

Regarding claim 7, the combination of Calvert and Hymel discloses the digital advertising method according to claim 5 including the step of downloading the contents of the advertisements by a link to a web site and replaying the downloaded contents on the screen of the cellular telephone and a home audio/video device (Calvert, col. 7, lines 12-21 and col. 8, lines 42-47).

Regarding claim 8, the combination of Calvert and Hymel discloses the digital advertising method of claim 1 as described above.

The combination, however, fails to disclose including the categories from the group consisting of emergencies, sports, shopping and investing.

Calvert, however, discloses that the products discussed throughout refer to any type of goods or services that may be provided to a user of a communication device (col. 3, lines 14-17).

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Calvert and Hymel to include the services of emergencies, sports, shopping and investing since such services are well

known in the art to be broadcast to a user of communication device automatically or upon request, based on the subscribed services of the user.

Regarding claim 9, the combination of Calvert and Hymel discloses the advertising method/system which corresponds to the method/system of claim 1. It is obvious in that it simply provides structure for the logical implementation found in claim 1.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-

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5837. The examiner can normally be reached Monday-Friday (alternate Fridays) from 9:00am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Davis  
Examiner  
Art Unit 2681

April 18, 2004

  
**TEMICA M. DAVIS**  
**PATENT EXAMINER**

  
**ERIKA GARY**  
**PATENT EXAMINER**